REMARKS

Presently, claims 1-21 and 42-84 are pending in the application. Claims 2, 6, 8-10, 12, 18, 50, 51, 56 and 57 have been amended to correct formal errors noted by Applicants and to more clearly recite the present invention. Claims 22-41 have been canceled and rewritten as new claims 64-84. Support for the features of new claims 64-84 may be found, for example, in claims 1-21, respectively, and claims 22-41 (now canceled). Since these amendments are of a formal nature, no new matter has been added to the application.

Double Patenting Rejection

The Examiner has rejected claims 1-54 under the judicially created doctrine of Double Patenting (obviousness type). The Examiner asserts that claims 1-54 are unpatentable over claims 1-27 of U.S. Patent No. 6,324,519 to Eldering ("the '519 patent"). Applicants respectfully traverse this rejection.

Initially, Applicants respectfully submit that the Examiner has not set forth sufficient reasons in support of this double patenting rejection, other than stating that the claims "are not patentably distinct from each other because they are obvious variation of each other" (see page 2 of the Office Action). As set forth in MPEP § 804(II)(B)(1), any obviousness-type double patenting rejection should make clear:

> (A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and
>
> (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

However, the Examiner has not explained the differences between the claims of the '519 patent and the claims of the present invention, nor has the Examiner given any

reason why the presently pending claims are an obvious variation of those in the '519 patent. Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of an obviousness determination under 35 U.S.C §103. *Id.* Thus, to the extent that the following remarks regarding the merits of the Examiner's double patenting rejection are not sufficient, Applicants respectfully request that the Examiner provide detailed reasons in accordance with the MPEP in support of the double patent rejection.

Applicants respectfully disagree with the Examiner's broad assertion that the claims of the '519 patent and those of the present application are an obvious variation of each other. Claims 1-27 of the '519 patent are directed towards the auctioning of advertisement opportunities (see, for example, claim 1 of the '519 patent). However, the claims recited in the present application do not establish price through a competitive auction, but rather are directed toward generating a proposed advertisement avail price based on a correlation of available units and avail inventory data.

More specifically, and by way of example, claim 1 of the present invention recites, in part, "correlating available addressable units of the communications network with the avail inventory data." None of the elements recited in the claims of the '519 patent teach or suggest correlating available addressable units of the communications network with avail inventory data. For example, claim 1 of the '519 patent recites "determining a correlation between the advertisement characterizations and the subscriber profile." Correlating ad characterizations and subscriber profiles is not the same as, nor does it suggest, correlating the factors of addressable units (*e.g.*, the number of subscribers) with avail inventory data. Accordingly, it would not have been obvious for one skilled in the art to substitute two completely different factors in a correlation process that are implemented to reach two different goals.

Furthermore, the claims of the '519 patent do not teach or suggest "generating a proposed price for purchase of at least one avail based on the results of the correlating step." In contrast, the claims of the '519 patent recite a method for auctioning advertisement opportunities by "receiving bids from the advertisement opportunity from

the advertisers" (see claim 1 of the '519 patent). Auctioning advertisement time, thereby determining price through a competitive process (e.g., the '519 patent), is not the same as, utilizes a completely different methodology than, and produces a completely different result compared to, a communications network generating an advertisement price that an advertiser either takes or leaves (e.g., the present invention). As such, Applicants respectfully submit that the claims of the present invention are not obvious variations of and are patentably distinct from the claims of the '519 patent.

Claims 22-41 have been canceled. Reconsideration and withdrawal of the Examiner's double patenting rejection of claims 1-54 are respectfully requested.

Claim Rejections – 35 U.S.C. 112

The Examiner has rejected claim 8 under 35 U.S.C. §112, second paragraph, as lacking antecedent basis for the term "the proposed price." Applicants respectfully traverse the rejection.

Claim 1, from which claim 8 depends, recites "generating a proposed price." Accordingly, the phrase "the proposed price" recited in claim 8 has proper antecedent basis.

The Examiner has rejected claim 30 under §112, second paragraph, noting that claim 30 is dependent on claim 31, which depends from claim 30. Claims 30 and 31 have been canceled. Accordingly, the Examiner's §112, second paragraph, rejection of these claims is moot. Reconsideration and withdrawal of the Examiner's rejection of claims 8 and 30 are respectfully requested.

Prior Art Rejection – 35 U.S.C 102(e)

The Examiner has rejected claims 1-4, 6-13, 16-25, 27-33, 36-43 and 46-63 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,463,585 to Hendricks *et al.*

("Hendricks"). The Examiner contends that Hendricks teaches all elements of these claims. Applicants respectfully traverse this rejection.

Hendricks discloses a system for providing television programming and targeted advertisements to consumers' homes. In Hendricks, information is sent from a program controller to local storage and/or real-time display on a consumer's terminal. The stored information may include control information, programming and/or advertisements. Additionally, Hendricks discloses that information related to users' preferences and viewing actions or habits may be observed, retrieved and analyzed, such that a particular consumer terminal may be identified to a desired target category. The target category, based, for example, on demographic information, is utilized to determine which advertisements to target at the consumer.

Hendricks teaches that the advertisements are assigned to viewer groups with similar characteristics. A software subroutine performs the assignment of advertisements to available time slots:

> This selection process typically involves advertisements from various advertisement categories (from a number of advertisers which have purchased "airtime"). Each advertisement will subsequently be assigned a number of times that it will be shown in a give time frame. . . . This frequency of display may be based on various factors, including the number of requests and cost paid by the respective advertiser. . . . These weightings are used to prioritize the advertisements that will be sent to individual set top terminals or group of set top terminals. (column 71, lines 11-29).

Only after the advertisements have been scheduled and displayed is the billing cost to the advertiser calculated (see column 71, lines 42-49). Although Hendricks takes advertiser preferences into consideration when filling up advertisement avail slots, Hendricks' system does not give advertisers the option of selecting particular ad slots.

Applicants' invention is directed to a system and method for allowing advertisers to buy advertisement time through a computerized system with minimal or no sales

representative involvement in the transaction. Advertisers can select advertisement slots and the size of the target audience based on a price that is set by correlating the number of subscribers in the target audience with the inventory of unsold advertising time slots.

Independent claim 1 recites:

> A computer-implemented method for managing avail inventory data of media programming streams for a communications network, the method comprising the steps of:
>
> correlating available addressable units of the communications network with the avail inventory data; and
>
> generating a proposed price for purchase of at least one avail based on results of the correlating step.

Hendricks does not disclose correlating available addressable units of the communications network with avail inventory data. The passage of Hendricks cited by the Examiner (column 4, line 54 – column 5, line 51) refers only to the assignment of subscribers to groups based on subscriber characteristics and the storage of group assignments at viewer's television terminals. In fact, the passage demonstrates that Hendricks does not address avail inventory since, "for some programming the occurrence of program breaks cannot be predicted in advance of programming airing" (column 5, lines 41-43). Thus, Hendricks does not disclose accounting for avail inventory (let alone correlating factors with such inventory), since Hendricks' system does not even know when all the available time slots will be – i.e., there is no fixed inventory.

Hendricks also does not disclose the generation of a proposed price based on correlation of avail inventory and available addressable units. Rather, Hendricks bills advertisers only after the advertisements have been shown (column 71, lines 40 – 47). Thus, not only does Hendricks not discuss a methodology for advertisement pricing in which advertisers receive proposed prices, but Hendricks does also not disclose generating such prices based on the a the correlation of avail inventory and available addressable units. In contrast, the present invention allows advertisers to select from an avail inventory and available addressable units to receive a proposed price for an

advertisement. Hendricks merely discloses that a "subroutine selects a set of commercials that will be used in the chosen [subscriber] groupings" (column 71, lines 13-18). Thus, Hendricks does not disclose all of the elements of independent claim 1. Accordingly, independent claim 1 is believed to be allowable over Hendricks.

Independent claim 42 recites "A management system for managing avail inventory data of media programming...comprising...correlating available addressable units of the communications network with the avail inventory data...and generating a proposed price for purchase of at least one avail based on results of the correlation." Similarly, new independent claim 64 recites, "correlating available addressable units of the communications network with the avail inventory data; and...generating a proposed price for purchase of at least one avail based on results of the correlating...." For the same reasons discussed above with respect to independent claim 1, Hendricks not disclose all of the elements of independent claims 42 and 64. Accordingly, independent claims 42 and 64 are believed to be allowable over Hendricks.

Claims 2-4, 6-13, 16-21, 43, 46-63 and 65-84 are allowable at least by their dependency on independent claims 1, 22 and 42, respectively. Claims 22-25, 27-33 and 36-41 have been canceled. Reconsideration and withdrawal of the Examiner's rejection of claims 1-4, 6-13, 16-25, 27-33, 36-43 and 46-63 are respectfully requested.

Prior Art Rejection – 35 U.S.C. 103(a)

The Examiner has rejected claims 5, 14, 15, 26, 34, 35, 44 and 45 under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of U.S. Patent No. 6,424,998 to Hunter ("Hunter"). Applicants respectfully traverse this rejection.

As discussed above with respect to independent claims 1, 42 and 64, Hendricks does not disclose all of the features of the present invention.

Hunter discloses a system and method for advertisers to schedule and provide content for electronic advertising displays in public places (column 2, lines 39-45).

Hunter is not directed towards advertisements sent to multiple subscribers in a communications network and does not disclose generating a proposed price for advertisements based on a correlation of available addressable units with the avail inventory. As such, Hunter does not teach or suggest the element(s) missing from Hendricks. Therefore, even if the combination of Hendricks and Hunter is proper, such combination does not teach of suggest all of the features of independent claims 1, 42 and 64. Accordingly, Applicants respectfully submit that independent claims 1, 42 and 64 are allowable over the combination of Hendricks and Hunter.

Dependent claims 5, 14, 15, 44 and 45 are allowable at least by their dependency on independent claims 1 and 42, respectively. Claims 26, 34 and 35 have been canceled. Reconsideration and withdrawal of the Examiner's rejection of claims 5, 14, 15, 26, 34, 35, 44 and 45 are respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 1-21 and 42-84 is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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